

REMARKS

Claims 1 and 4-21 are presented for examination. Claims 1 and 4-11 are allowed.

Claims 12-17, 19 and 20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Daines et al. Dependent claims 18 and 21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Daines et al. in view of Joung et al. These rejections are respectfully traversed for the following reasons.

In the application of a rejection under 35 U.S.C. §103, it is incumbent upon the Examiner to factually support a conclusion of obviousness. The Examiner must provide a reason why one having ordinary skill in the art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985). *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). This showing by the Examiner is an essential part of complying with the burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

As demonstrated below, the Examiner has failed to provide the requisite reasons for modifying Daines and thus to establish a *prima facie* case of obviousness.

Independent claim 12 recites a network interface device for providing an interface between a data network and a computer system, the network interface device comprising:

- a descriptor management unit for managing receive descriptors pointing to receive buffers allocated to receive data from the network medium, and

- an automatic flow control mechanism for automatically performing flow control in accordance with the number of available receive descriptors pointing to the receive buffers available for receiving data from the network medium.

Independent claim 19 recites a method of automatic flow control in a network interface between a data network and a computer system. The method comprises the steps of:

- monitoring the number of receive descriptors pointing to buffers in the computer system available for receiving data from the network, and

- automatically requesting a remote station in the data network to suspend data transmission when the number of receive descriptors falls below a first preprogrammed threshold level.

The Examiner admits that Daines et al. “fails to disclose means wherein the buffers are specifically referred to by descriptors.”

Accordingly, Daines does not teach or suggest an automatic flow control mechanism for automatically performing flow control in accordance with the number of available receive descriptors pointing to the receive buffers available for receiving data from the network medium, as claim 12 requires.

Also, Daines does not teach or suggest monitoring the number of receive descriptors pointing to buffers in the computer system available for receiving data from the network, and automatically requesting a remote station in the data network to suspend data transmission when the number of receive descriptors falls below a first preprogrammed threshold level, as claim 19 requires.

Further, the Examiner points out that “these features are well known in the art and it would have been an obvious modification of the system disclosed by Daines et al.”

It is noted that the Examiner has failed to cite a reference that discloses the features considered to be “an obvious modification.” If the Examiner relied upon common knowledge of the art or “well known” prior art without expressly indicating such reliance, the Examiner is respectfully requested to cite a reference in support of his position (see MPEP 2144.03).

Moreover, the Examiner has failed to provide a reason why one having ordinary skill in the art would have been led to modify Daines to arrive at the inventions claimed in claims 12 and 19.

Instead, the Examiner asserts that “since the flow control apparatus of the reference must have name and location information for the managed buffer, the function of a descriptor is inherent. Specifically calling this information a “descriptor” does not further limit the claim. The use of this identifying information benefits the system by allowing each buffer to be distinguished by name or location.”

This assertion is respectfully traversed. If the flow control apparatus of Daines has name and location information for the managed buffer, as the Examiner contends, there is no need to modify this apparatus “by allowing each buffer to be distinguished by name or location.” If the buffer has name and location, it is already distinguished by name and location.

Accordingly, the Examiner provides no valid reasons for modifying the flow control apparatus of Daines to incorporate the claimed features.

Considering the reference, Daines discloses a flow control mechanism including a level indicator indicating the amount of data stored in the buffer. Preset high and low threshold levels define the maximum data level and a “restart” level (col. 6, line 58 to col. 7, line 4). The flow control device 25 monitors the level indicators for each buffer to determine if the amount of data stored therein exceeds a threshold level (col. 7, lines 6-9).

The reference provides no reason to modify the flow control device of Daines to monitor the number of receive descriptors pointing to receive buffers, and

automatically performs flow control in accordance with the number of available receive descriptors pointing to the receive buffers, as claim 12 requires, or

automatically requests a remote station in the data network to suspend data transmission when the number of receive descriptors falls below a first preprogrammed threshold level, as claim 19 recites.

It is not apparent why one skilled in the art would have recognized any advantage to be gained by modifying Daines.

Further, it is well settled that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103, two basic criteria must be met. First, there must be some suggestion or motivation in the references themselves to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success for the modification or combination of references. The teaching or suggestion to make the modification or combination of prior art and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As demonstrated above, Daines contains no suggestion or motivation for the proposed modification, and provides no reasonable expectation of success.

Moreover, Daines expressly **teaches away** from the claimed invention, thereby constituting further **evidence of nonobviousness**. *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986); *In re Marshall*, 578 F.2d 301, 198 USPQ 344 (CCPA 1978).

In particular, instead of monitoring the number of receive descriptors pointing to receive buffers, Daines suggests monitoring a level indicator indicating the amount of data stored in the buffer.

In the absence of a teaching or suggestion in the reference of the details recited in the claims, it is submitted that a conclusion of obviousness is not warranted.

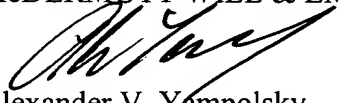
In view of the foregoing, and in summary, claims 1 and 4-21 are considered to be in condition for allowance. Favorable reconsideration of this application is respectfully requested.

Application No.: 09/482,327

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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